

REMARKS

Claims 1 and 3-34 are pending in this patent application.

§ 102 Rejection

The Examiner rejects claims 1, 3, 5, 8, 29, and 32 for being anticipated by U.S. Patent 4,960,121 to Nelson et al. (Nelson). In making this rejection, the Examiner contends that "the Nelson reference lacks a rigid insert and is of a non-elastomeric material". In taking this position, the Examiner cites column 2, lines 20-40 of Nelson. In this location, Nelson explicitly states that "the half-mask assembly of this invention is indicated generally at 10 and includes four major components, these being a hard shell indicated generally at 12, a face seal indicated generally at 14, a head harness assembly indicated generally at 16, and a pair of harness anchors and adjusters, each of which is indicated generally at 18". Nelson's combination of the hard shell 12 and face seal 14 comprise a mask body. The hard shell 12 satisfies applicants' definition of a "rigid insert":

"Rigid insert" refers to a relatively stiff structural member that has been used on respiratory masks to provide adequate structure for attaching fluid communication components such as filter cartridges and exhalation valves while being joined to a more compliant portion that makes contact with and generally conforms to a wearer's face; and

Please also note that applicants have defined the terms "mask body" as follows:

"Mask body" means a structural member that is configured to fit over a person's nose and mouth and that helps define an interior gas space separate from an exterior gas space;

Because Nelson's hard shell 12 clearly satisfies applicants' definition of a rigid insert, it cannot be properly contended that the Nelson mask body lacks such a rigid insert. Since Nelson describes a mask body that contains a rigid insert and since applicants' invention requires a mask body that **lacks** a rigid insert, Nelson would not have anticipated applicants' invention under the terms of 35 USC § 102.

The Examiner also contends that the Nelson mask body is constructed such that its first and second cheek portions can move towards each other about an axis that extends from the nose

portion to the chin portion of the mask body. The Examiner believes that this is inherently shown in Figure 7. Applicants' review of Figure 7, however, only reveals a mask body that is worn on a person's face. There is no indication that the cheek portions could deflect about an axis that extends from the nose portion to the chin portion. As the Examiner is aware, any limitation that is contended to be inherently present in a reference must be described in the reference such that it is the natural result that flows from the disclosure. In other words, the feature in question must be necessarily present in the reference cited. Mere speculation and probabilities do not satisfy the requirements for an inherent disclosure.¹ The Nelson patent indicates that the mask body 10 comprises a hard shell 12. There is nothing in Nelson which would indicate that this hard shell would deflect about an axis that extends from the nose portion to the chin portion. In contrast, applicants have designed a respirator that lacks a rigid insert so that such deflection can occur. Nelson therefore also would not have anticipated applicants' invention because there is nothing in Nelson which suggests that this deflection about such an axis is necessarily present.

The Examiner further contends that "it would have been obvious to one having ordinary skill in the art at the time that the invention was made to provide a numerical value of the deflection or a numerical value of the force required for the mask body deflection test, since it has been held that discovering an optimum value of result effective variable involves only routine skill in the art." Firstly, the Examiner is misconstruing the *In re Boesch*² decision. *In re Boesch* does not hold that all optimum values of result effective variables involve only routine skill in the art. As the Federal Circuit stated on numerous occasions, each case of obviousness must be decided on its own fact pattern and merits. Applicants have provided numerical values on the degree of deflection in claims 19 and 20 to specify how easily the mask can be deflected so that a better fit can be achieved to a wearer's face. As indicated above, there is nothing in Nelson which indicates that its mask body can be deflected at all, much less at least 5 mm with an average force of 5 Newtons applied to the mask body. Nor is there anything described in Nelson which would lead one to conclude that a deflection of at least 10 mm could occur with an average force of only 5 Newtons being applied to the mask body.

¹ *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746 (Fed. Cir. 1991), *reh'ng denied*, (Dec. 26, 1991).

² 617 F.2d 272, 205 USPQ 215 (CCPA 1990).

For the reasons presented above, applicants believe that the outstanding rejection based on Nelson must be withdrawn.

Respectfully submitted,

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Date

By: _____/Karl G. Hanson/

Karl Hanson, Reg. No.: 32,900

Telephone No.: 1-651-736-7776

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833